



1652
31800

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: KUBOTA et al.

Art Unit: 1652

U.S. Application No.: 10/089,549
Nationalized: April 1, 2002

Conf. No. 3265

Examiner: M. N. RAO

I.A. No.: PCT/JP01/06412
I.A. Date: July 7, 2001

Washington, D.C.

Atty.'s Docket: KUBOTA=9

For: α -ISOMALTOSYLGLUCOSACCHARIDE-FORMING ENZYME, PROCESS AND USES OF...

Date: November 10, 2003

Mail Stop
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a [] Amendment [XX] REPLY TO RESTRICTION AND ELECTION REQUIREMENTS
in the above-identified application.

[] Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

[XX] No additional fee is required.

[] The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20	0
INDEP.	*	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 9	\$
x 42	\$
+ 140	\$
ADDITIONAL FEE TOTAL	
\$	

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 18	\$
x 84	\$
+ 280	\$
TOTAL	
\$	

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

[] First - \$ 55.00
[] Second - \$ 200.00
[] Third - \$ 460.00
[] Fourth - \$ 720.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

[] First - \$ 110.00
[] Second - \$ 400.00
[] Third - \$ 920.00
[] Fourth - \$ 1440.00

Month After Time Period Set

[] Less fees (\$) already paid for month(s) extension of time on .

[] Please charge my Deposit Account No. 02-4035 in the amount of \$.

[] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$.

[] A check in the amount of \$ is attached (check no.).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: KUBOTA=9

In re Application of:)	Conf. No.: 3265
)	
Michio KUBOTA et al.)	Art Unit: 1652
)	
U.S. Appln. No.: 10/089,549)	Examiner: M. N. RAO
Nationalized: April 1, 2002)	
)	Washington, D.C.
I.A. No.: PCT/JP01/06412)	
I.A. Date: July 7, 2001)	
)	
For: ALPHA-ISOMALTOSYLGLUCOSACCH-)	November 10, 2003
ARIDE SYNTHASE, PROCESS...)	<u>MONDAY</u>

REPLY TO RESTICTION AND ELECTION REQUIREMENTS

Mail Stop
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants are in receipt of the Office Action
mailed October 9, 2003, entirely in the nature of a
requirement for restriction and a requirement for election of
species.

The applicants have claimed benefit of applications
filed in Japan in August of 2000, and the PTO has indicated
that "priority document" has been received; applicants assume
that both priority documents have been received. Accordingly,
applicants respectfully request the Examiner to acknowledge
receipt of applicant's papers filed under §119.

First, as regards the restriction requirement, and in view of the fact that applicants must make an election even though the requirement is traversed, applicants hereby provisionally and respectfully elect Group I, presently claims 1-15, with traverse and without prejudice.

The Examiner recognizes that normal restriction practice does not apply because the present application is the U.S. National phase of a PCT application, i.e. Unity of Invention rules apply instead. Under the provision of PCT Rules 13.1 and 13.2, unity of invention exists, i.e. the restriction requirement is improper. The **claims**, not a partial reading of the claims, share the same or corresponding technical features. No prior art has been cited to show that this is not so.

Applicants note that the claimed isomaltosylglucosaccharide-forming enzyme is a totally new enzyme and that the cyclotetrasaccharide as defined in claim 16 is obtainable using the claimed isomaltosylglucosaccharide-forming enzyme. It is therefore believed that the two inventions are so closely related as to be examined in a single application without imposing any undue burden on the Examiner.

Applicants further rely on the second paragraph of MPEP 803 which **requires** a search and examination of plural inventions, even though the restriction requirement is

correct, if it would not constitute a serious burden to do so. No separate classification has been pointed out. The inventions are closely related. Applicants submit that no serious burden exists, and the requirement should be withdrawn on this basis as well.

Withdrawal of the restriction requirement is respectfully requested.

As regards the Election of Species requirement, again applicants must make an election even though they traverse the requirement. Accordingly, applicants hereby respectfully and provisionally elect SEQ ID NO: 11, with traverse and without prejudice. The claims which read on this species are claims 1-10, 12-27 and 29-42.

Again, applicants believe and submit that the requirement is inconsistent with Unity of Invention rules, in particular PCT Rules 13.1 and 13.2. The same or corresponding special technical feature among the species is what is expressed in the generic claims.

As a second reason for this traversal, applicants again rely on the second paragraph of MPEP 803 and note the lack of serious burden as regards at least some of the species which are similar to the elected species SEQ ID NO: 11. Again, no separate classification is noted and similarity among species warrants consideration together, especially

Appln. No. 10/089,549
Amdt. dated November 10, 2003
Reply to Office Action of October 9, 2003

taking into account the immense burden which would be placed on the applicants if they were to be required to file an additional eight (8) patent applications.

Accordingly, applicants request at least partial withdrawal of the election of species requirement and the examination of plural species.

Applicants now respectfully await the results of a first examination on the merits.

Respectfully submitted,

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Attorneys for Applicant(s)

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